

## REMARKS

The Official Action of October 1, 1996, and the references cited therein have been carefully considered. Reconsideration of the application in view of the above amendments and the following remarks is respectfully requested.

Claims 1-28 have been canceled without prejudice and rewritten as new Claims 29-55. The claims remaining therefore are Claims 29-55.

Applicants apologize for the length of the subject Amendment, but they believe that rewriting the claims in their entirety is the easiest way to ensure proper entry of the amendments thereto.

The specification has been amended to update the status of parent application Serial No. 08/169,889.

Claims 1-28 (now Claims 29-55) stand rejected under 35 U.S.C. § 103(a) as being obvious over, or in the alternative stand rejected under 35 U.S.C. § 102(a) as being anticipated by Dorn et al., U.S. 5,512,570. Applicants respectfully traverse this rejection and submit that the instant invention would not have been obvious to one of ordinary skill in the art in view of Dorn et al., U.S. 5,512,570, nor would the instant invention have been anticipated by Dorn et al., U.S. 5,512,570.

Dorn et al., U.S. 5,512,570 (priority date of March 4, 1994) discloses certain morpholine compounds as tachykinin receptor antagonists.

Applicants respectfully assert that the disclosure in their priority applications effectively antedates the cited reference. The instant application claims priority, e.g. from parent application Serial No. 08/169,889, filed December 17, 1993, and PCT Int'l Appln. PCT/US94/14497, filed December 13, 1994. Applicants respectfully note that the instant application was filed to correct minor errors and to ensure consistency between the disclosure in the PCT application (and any foreign applications therefrom) and the instant U.S. application. For example, with respect to Serial No. 08/169,889, the instant application corrects the nomenclature of some of the specific compounds (i.e. the designation of saturation "1H,4H" is used consistently among compounds with a "5-oxo-1,2,4-triazolo" moiety). In addition, examples are presented on pages 98-99 to facilitate ready comprehension of the chemical structures corresponding to the nomenclature employed in the present application. Also, another method for preparing the specific compounds (e.g., the title compound of Example 75) is provided in Examples 94-105.

Applicants respectfully submit that the instant claims are fully supported by the specification and claims of e.g., parent application Serial No. 08/169,889, and are entitled to the filing date of this parent application (as well as the other priority applications). With reference to the instant claims, Claims 1-14 (now Claims 29-42) find support e.g., on page 8-30 and the claims of parent application Serial No. 08/169,889. Claim 15 (now Claim 43) is supported by e.g., pages 30-83 and the claims of parent application Serial No. 08/169,889. As noted above, the more definitive nomenclatural designation of "1H,4H" has been used consistently among the names of compounds bearing a "5-oxo-1,2,4-triazolo" moiety. Claims 16 and 17 (now Claims 44 and 45) find support e.g., in parent application Serial No. 08/169,889 on page 39, lines 10-11 (compound 96) and the title compound of Example 75 (page 177). Applicants respectfully submit that the structure of this compound would be readily apparent to one skilled in the art based on the name of the compound and the synthetic methodology employed to prepare the compound. Claims 18-28 (now Claims 46-55) are similarly supported by the description and claims of parent application Serial No. 08/169,889.

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If it would be convenient for the Examiner, Applicants would gladly provide a certified copy of parent application Serial No. 08/169,889 upon request.

Accordingly, the rejection of Claims 1-28 (now Claims 29-55) under 35 U.S.C. § 103(a) as being obvious over, or in the alternative the rejection under 35 U.S.C. § 102(a) as being anticipated by Dorn et al. (U.S. 5,512,570), is untenable and should be withdrawn.

Claims 1-28 (now Claims 29-55) stand rejected under 35 U.S.C. § 103(a) as being obvious over, or in the alternative stand rejected under 35 U.S.C. § 102(a) as being anticipated by Dorn et al., EP 0,577,394 (published January 5, 1994) or Barker et al., PCT Publication No. WO 95/18124 (published July 6, 1995).

Applicants respectfully traverse this rejection and submit that the instant invention would not have been obvious to one of ordinary skill in the art in view of Dorn et al., EP 0,577,394, or Barker et al., PCT Publication No. WO 95/18124, nor would the instant invention have been anticipated by Dorn et al., EP 0,577,394, or Barker et al., PCT Publication No. WO 95/18124.

Applicants note that Dorn et al., EP 0,577,394, corresponds to a foreign filed application based on the grandparent application USSN 08/061,914 (and its parent applications). Priority from USSN 08/061,914 (and its parent applications) was claimed under 35 U.S.C § 120 for the instant application. Accordingly, the present claims are fully supported by the disclosure of USSN 08/061,914 (and its parent applications) with respect to the teachings of Dorn et al., EP 0,577,394.

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In addition, as fully discussed above Applicants respectfully submit that the instant claims are fully supported by the specification and claims of e.g., parent application Serial No. 08/169,889, filed December 17, 1993, and are entitled to the filing date of this parent application (as well as the other priority applications) which is prior to the publication of both Dorn et al., EP 0,577,394 (published January 5, 1994) and Barker et al., PCT Publication No. WO 95/18124 (published July 6, 1995).

Accordingly, the rejection of Claims 1-28 (now Claims 29-55) under 35 U.S.C. § 103(a) as being obvious over, or in the alternative under 35 U.S.C. § 102(a) as being anticipated by Dorn et al. (EP 0,577,394) or Barker et al. (PCT Publication No. WO 95/18124) is untenable and should be withdrawn.

Claims 1-28 (now Claims 29-55) stand rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. Although Applicants believe that the claims are clear, Claims 1-28 have been rewritten as new Claims 29-55 to delete the phrase "are as defined above". Accordingly, the rejection of Claims 1-28 (now Claims 29-55) under 35 U.S.C. § 112, second paragraph, for indefiniteness has been overcome.

Applicants have attempted to make the Information Disclosure Statement of December 6, 1995, as complete as possible, but they would gladly furnish any reference mentioned in the application to the Examiner upon request.

Claims 1-28 (now Claims 29-55) stand rejected under the judicially created doctrine of obviousness-type double patenting over Claims 1-15 of U.S. Patent No. 5,512,570.

Applicants respectfully traverse this rejection and submit that the claimed invention would not have been obvious to one of ordinary skill in the art in view of the claims of Dorn et al., U.S. 5,512,570. Dorn et al. claims the use of certain morpholine compounds for the treatment or prevention of emesis. All of these compounds possess a moiety identified as "X" such as a phosphoryl group on the morpholine compound. Nevertheless, there is nothing in the claims of Dorn et al. to suggest either morpholine compounds wherein the "X" substituent is removed or morpholine compounds which does not possess the "X" substituent. Accordingly, the instant claims are not rendered obvious by the disclosure in the claims of Dorn et al., U.S. 5,512,570.

Accordingly, the rejection of Claims 1-28 (now Claims 29-55) under the judicially created doctrine of obviousness-type double patenting over Claims 1-15 of U.S. Patent No. 5,512,570 is untenable and should be withdrawn.

Regarding the Kaufmann reference (U.S. Patent No. 5,457,107; filed September 16, 1994), Applicants note that this reference is directed to a specific polymorphic form of the compound 2-(S)-(3,5-bis-(trifluoromethyl)benzyloxy)-4-(3-(5-oxo-1H,4H-1,2,4-triazolo)methyl)-3-(S)-phenyl-morpholine. Accordingly, the instant claims are not obvious over nor anticipated by the disclosure of Kaufmann (U.S. Patent No. 5,457,107). In addition, the instant claims are patentably distinct and not obvious over the claims of Kaufmann (U.S. Patent No. 5,457,107). Moreover, as discussed above, the instant claims are fully supported by the specification and claims of e.g., parent application Serial No. 08/169,889, filed December 17, 1993, and are entitled to the filing date of this parent application (as well as the other priority applications) which is prior to the effective date of Kaufmann (U.S. Patent No. 5,457,107).

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Regarding the Laduwahetty et al. (Bioorg. Med. Chem., 4 (16), 1917-1920 (1994)) reference, Applicants note that this reference discloses the specific compound 2-(3,5-bis-(trifluoromethyl)benzyloxy)-3-phenyl-morpholine. Applicants submit that the instant claims are not obvious over nor anticipated by the disclosure of Laduwahetty et al. As discussed above, the instant claims are fully supported by the specification and claims of e.g., parent application Serial No. 08/169,889, filed December 17, 1993, and are entitled to the filing date of this parent application (as well as the other priority applications) which is prior to the publication date Laduwahetty et al.

Applicants have reviewed the specification and have no corrections other than the foregoing amendment to update the status of parent application Serial No. 08/169,889.

Applicants respectfully contend that the application is allowable and a favorable response from the Examiner is earnestly solicited.

Respectfully submitted,

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